

REMARKS

Claims 1-20 are currently pending in the subject application and are presently under consideration. Claims 1, 14, and 20 have been amended as shown on pages 2-5 of the RCE Submission. No new matter has been added.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-20 Under 35 U.S.C. § 101

In the Final Office Action dated May 12, 2008, claims 1-20 stand rejected under 35 U.S.C. § 101 on the grounds that the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reason. The subject claims are directed to statutory subject matter in accordance with 35 U.S.C. § 101. Independent claim 1, as amended, recites: *[a] system that facilitates free form digital inking, the system is recorded on a computer-readable medium and capable of execution by a computer, comprising: a processor; an annotation management component that generates a zoom window comprising an inking region for a digital document; and a navigation component that manually and automatically re-positions and re-sizes the zoom window and the inking region relative to the digital document, the re-position and re-size of the zoom window and the inking region occurs at least as an annotation of the digital document is entered in the inking region during an annotation event based at least in part on an amount of annotation information entered and displayed in the inking region, the size of the zoom window corresponds to the size of the inking region.*

The claimed subject matter relates to a system that can facilitate free form digital inking, wherein the **system is recorded on a computer-readable medium and capable of execution by a computer**. The claimed subject matter includes components, such as **a processor, an annotation management component** and **a navigation component**, which can facilitate free form digital inking associated with documents (e.g., digital documents). The claimed subject matter, comprising a processor, can facilitate free form digital inking, and can produce a useful, concrete, and tangible result. Thus, the claimed subject matter is directed to a tangible embodiment and is therefore in accordance with 35 U.S.C. § 101.

Further, independent claim 14, as amended, recites: *[a] computer-implemented method that provides a zoom window to annotate digital documents with digital ink, comprising: generating the zoom window comprising an inking region to facilitate initiating an annotation event; scaling contents displayed in the zoom window; manually and automatically re-positioning and re-sizing the zoom window and the inking region relative to at least one digital document . . . ; positioning the zoom window over an area of interest; navigating the zoom window after annotating the at least one digital document; and terminating the annotation event after the annotation information is entered in the inking region.*

The claimed subject matter is a **computer-implemented method** that provides a zoom window to annotate digital documents, wherein digital documents can be annotated as desired. Further, the claimed subject matter can be implemented by a computer. The claimed subject matter is therefore directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Furthermore, for at least reasons similar to the reasons stated with regard to independent claim 1, independent claim 20, as amended, is directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Thus, independent claims 1, 14 and 20 (and associated dependent claims) recite statutory subject matter as they can produce a useful, concrete, and tangible result such to be classified as patentable subject matter according to 35 U.S.C. § 101.

In view of at least the foregoing, it is readily apparent that the subject claims are directed to statutory subject matter in accordance with 35 U.S.C. § 101. Accordingly, withdrawal of this rejection is requested.

II. Rejection of Claims 1-2, 4-16, and 18-20 Under 35 U.S.C. § 103(a)

In the Final Office Action dated May 12, 2008, claims 1-2, 4-16, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price *et al.* (US Pub. No. 2001/0043716) (hereinafter “Price *et al.*”) in view of Nagae (U.S. Pat. No. 6,230,169) (hereinafter “Nagae”). Withdrawal of this rejection is respectfully requested for at least the following reason. Price *et al.* and Nagae, either alone or in combination, fail to disclose, teach, or suggest each and every element set forth in the subject claims. To reject claims under 35 U.S.C. § 103(a),

the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. See MPEP § 706.02(j). The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed subject matter relates to systems and methods that can facilitate annotating digital documents (*e.g.*, word processing documents, images, *etc.*) displayed devices (*e.g.*, desktop computers, Tablet personal computers (PCs), personal digital assistants (PDAs), cellular phones, and the like). (*See* p. 3, lns. 13-16.) In one aspect, the claimed subject matter can provide a focus plus context-based interface that can enable multi-scale navigation during document annotation. (*See* p. 7, lns. 5-6.) The interface can zoom a region of an underlying document, wherein a user can enter annotations in the region at a size comfortable to the user and suitably scaled to the device display. (*See* p. 3, lns. 16-19.)

In particular, independent claim 1, as amended, recites: *a navigation component that manually and automatically re-positions and re-sizes the zoom window and the inking region relative to the digital document, the re-position and re-size of the zoom window and the inking region occurs at least as an annotation of the digital document is entered in the inking region during an annotation event based at least in part on an amount of annotation information entered and displayed in the inking region, the size of the zoom window corresponds to the size of the inking region.* Price *et al.* and Nagae, either alone or in combination, do not teach or suggest the distinctive aspect of the claimed subject matter.

Rather, Price *et al.* relates to a system and method that enables free-form digital ink annotation of data traces and storage management of the data trace based upon the free-form digital ink annotations. (*See* Abstract; p. 2, ¶ [0029].) Price *et al.*, teaches a system that can automatically select regions in the data trace based upon the position of the annotation and automatically summarize the data traces, and manage the storage of the data of a data trace based upon the freeform digital ink annotations. (*See* p. 2, ¶¶ [0028]-[0029].)

However, unlike the claimed subject matter, Price *et al.* fails to teach a zoom window let alone *automatically* re-positioning and re-sizing a zoom window and an associated inking region when an annotation of the digital document is entered in the inking region during an annotation event based on the amount of annotation information entered and displayed in the inking region, where the size of the zoom window corresponds to the size of the inking region. Instead, Price *et*

al. teaches that a user may be provided with control over the scale of the display of a data trace so that the scale of the entire data trace may be adjusted so that the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital ink annotation. (See Abstract; p. 2, ¶ [0033].) Thus, Price *et al.* simply teaches that the user can manually control the scale of the display of a data trace.

Further, Price *et al.* fails to teach that re-positioning and/or re-sizing a zoom window and an inking region occurs as an annotation associated with a digital document is entered in an inking region *during an annotation event*. Instead, Price *et al.* simply teaches that a data trace that contains annotations can be *summarized* to delete portions of the data trace that do not contain annotations and display only the portions of the data trace that are annotated with the annotations. (See p. 2, ¶¶ [0026]-[0029]; Figs. 2A and 2B.) Further, Figure 2B of Price *et al.* is not an inking region wherein an annotation is entered; rather, Figure 2B depicts a summary of the data trace and associated annotations created and displayed at a time *after* the annotations have been entered. (See p. 2, ¶¶ [0026]-[0029]; p. 4, ¶ [0044]; Figs. 2A and 2B.) Price *et al.* teaches that annotations are entered in a note taking area adjacent to but not directly correlated to the data trace. (See p. 2, ¶ [0033].)

Furthermore, Nagae fails to teach the distinctive features of the claimed subject matter as recited in independent claim 1. Rather, Nagae teaches an annotation display function that enables a user to check the contents of annotations while reading the text by reducing or enlarging the display image of an annotation input window with a specified magnification in displaying annotations and by superposing the displayed image in a specified position on the text display image on a text display screen. (See col. 1, lns. 42-49.) However, Nagae fails to teach *re-positioning and re-sizing a zoom window and an inking region as an annotation of a digital document is entered in the inking region during an annotation event based on the amount of annotation information entered and displayed in the region*. Instead, Nagae teaches changing the display magnification of a display image of the annotation based on a specified magnification that can be a system-specified magnification (e.g., default magnification) that can be prepared beforehand or a user-specified magnification. (See col. 2, lns. 21-37.) Nagae also teaches that an annotation input window that is of a fixed size when the user has opened the window on the screen, and the screen can be enlarged or reduced to the size determined by its bottom right end position and its top left end position, when the user moves the window's bottom right end with a

pen. (See col. 6, ln.67 – col. 7, ln. 5.) Further, unlike the claimed subject matter, Nagae also fails to teach a zoom window that is sized in correspondence with the size of an inking region.

In contrast, the claimed subject matter can facilitate free form digital inking associated with digital documents, which can facilitate annotation of digital documents. (See p. 8, ln. 29 – p. 9, ln. 3.) In one aspect, the claimed subject matter can create a zoom window that can comprise an inking region, which can be utilized to facilitate annotating the digital document. (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; Fig. 11.) The claimed subject matter can ***re-position and re-size the zoom window and inking region*** associated with a digital as an ***annotation of the digital document is entered in the inking region during an annotation event based at least in part on an amount of annotation information entered and displayed in the inking region.*** (See p. 10, ln. 18 – p. 11, ln. 2.) Further, ***the size (e.g., re-size) of the zoom window corresponds to the size (e.g., re-size) of the inking region.*** (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; p. 13, ln. 3-12; Fig. 11.) Thus, for instance, if the inking region increases in size to accommodate additional annotation information being entered in the inking region during an annotation event, the zoom window can correspondingly increase in size to facilitate display of the annotation information. As desired, an annotation event can be terminated by the user, where, for example, the user can accept the annotation and close the zoom window to terminate the annotation event. (See p. 13, lns. 3-12.)

For example, during an annotation event, a user can enter an annotation in an inking region contained within a zoom window. As the user enters annotation information in the inking region, the zoom window and inking region can be re-sized and/or re-positioned automatically during the annotation event, as desired, based at least in part on the amount of annotation information being entered and displayed in the inking region. (See p. 10, ln. 18 – p. 11, ln. 2.) Continuing with the example, if, during the annotation event, the zoom window, as currently sized, is full or close to becoming full (e.g., a portion of the annotation information is near the edge of the zoom window), the zoom window and inking region each can automatically increase in size (e.g., increase the size of the zoom window and create additional space in the inking region) and/or can be re-positioned to facilitate entering and displaying additional annotation information as such information is entered during the annotation event. (See p. 10, ln. 18 – p. 11, ln. 2; p. 17, ln. 29 – p. 18, ln. 1.) The change in size of the zoom window can correspond with

the change in size of the inking region. (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; Fig. 11.)

Further, independent claim 14, as amended, recites: *generating the zoom window comprising an inking region to facilitate initiating an annotation event; scaling contents displayed in the zoom window; manually and automatically re-positioning and re-sizing the zoom window and the inking region relative to at least one digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs at least as annotation of the at least one digital document is entered in the inking region during the annotation event as a function of an amount of annotation information entered and displayed in the inking region, wherein size of the zoom window corresponds to size of the inking region; . . . and terminating the annotation event after the annotation information is entered in the inking region.*

For at least reasons similar to the reasons stated with regard to independent claim 1, Price *et al.* and Nagae, either alone or in combination, do not disclose, teach, or suggest the distinctive aspects of the claimed subject matter. The cited art fails to teach *automatically re-positioning and re-sizing of the zoom window and the inking region* in relation to a digital document, where the *re-positioning and re-sizing of the zoom window and inking region occurs as annotation of a digital document is entered in the inking region during the annotation event*. Further, the cited art fails to teach that the size of the zoom window corresponds to the size of the inking region, such that when the inking region changes in size due to changes in the amount of annotation entered in the inking region during the annotation event, the zoom window correspondingly changes in size to accommodate the change in size of the inking region and change in the amount of annotation entered and displayed in the inking region.

Conversely, the claimed subject matter can initiate an annotation event to annotate a digital document by generating a zoom window that can comprise an inking region in which the annotation can be entered. (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; Fig. 11.) During the annotation event, as annotation information is entered into the inking region, the claimed subject matter can automatically re-size (e.g., increase size) and re-position the zoom window and inking region based in part on the amount of annotation information entered and displayed in the inking region. (See p. 10, ln. 18 – p. 11, ln. 2.) After the annotation information is entered into the inking region, the annotation event can be terminated, where, for example, a

user can accept the annotation and can close the zoom window to terminate the annotation event. (See p. 13, lns. 3-12.)

Moreover, independent claim 20, as amended, recites: *means for manual and automatic re-positioning and re-sizing of the annotation window and the inking region relative to the electronic document, the re-positioning and re-sizing of the annotation window and the inking region occurs at least as an annotation of the electronic document is entered in the inking region during an annotation event based at least in part on a quantity of annotation information entered and displayed in the inking region, wherein size of the annotation window corresponds to size of the inking region.*

For at least reasons similar to the reasons stated herein with regard to independent claims 1 and 14, Price *et al.* and Nagae, either alone or in combination, do not teach or suggest the distinctive aspect of the claimed subject matter as recited in independent claim 20. For instance, the cited art fails to teach automatic re-positioning and re-sizing of an annotation window and an associated inking region in relation to an electronic document as an annotation is being entered and displayed in the inking region during an annotation event.

In view of at least the foregoing, it is readily apparent that Price *et al.* and Nagae, either alone or in combination, fail to disclose, teach, or suggest each and every element of the claimed subject matter as recited in independent claims 1, 14, and 20 (and associated dependent claims 2, 4-13, 15, 16, 18, and 19). Accordingly, it is believed that the subject claims are in condition for allowance, and the rejection should be withdrawn.

III. Rejection of Claims 3 and 17 Under 35 U.S.C. § 103(a)

In the Final Office Action dated May 12, 2008, claims 3 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price *et al.* in view of Nagae and N.O. Bouvin *et al.*, “Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards”, Proceedings of the 11th international conference on World Wide Web, May 7-11, 2002, Honolulu, Hawaii, Pages 160-171 (hereinafter “Bouvin *et al.*”). Claim 3 depends from independent claim 1; and claim 17 depends from independent claim 14. Bouvin *et al.* fails to cure the aforementioned deficiencies of Price *et al.* and Nagae with regard to independent claims 1 and 14. Based at least on the foregoing reasons, withdrawal of the rejection is respectfully requested.

Further, claim 3 (and similarly claim 17) recites: *the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document*. Price *et al.* Nagae, and Bouvin *et al.*, either alone or in combination, fail to teach or suggest such distinctive feature of the claimed subject matter.

The Examiner states that Price *et al.* and Nagae fail to teach that the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document. (See Office Action dated May 12, 2008, p. 23, lns. 11-13.) Further, Bouvin *et al.* fails to teach the distinctive feature of the claimed subject matter. Rather, Bouvin *et al.* teaches animated opening/closing and a “push down” technique that gradually reveals a gloss while lines below the gloss are pushed down to make room. However, unlike the claimed subject matter, Bouvin *et al.* fails to teach an inking region that appears to grow out of a digital document.

In view of at least the foregoing, it is readily apparent that Price *et al.*, Nagae, and Bouvin, *et al.*, either alone or in combination, fail to disclose, teach, or suggest each and every element of the claimed subject matter as recited in claims 3 and 17. Accordingly, it is believed that claims 3 and 17 are in condition for allowance, and it is respectfully requested that the rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP592US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROC & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROC & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731